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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,649	12/13/2000	Mike Sage	MOC02 002	8281
7590 Dianoosh Salehi Duane Morris LLP Suite 700 1667 K Street, N.W. Washington, DC 20006			EXAMINER O'CONNOR, GERALD J	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 01/15/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20080111

Application Number: 09/736,649
Filing Date: December 13, 2000
Appellant(s): Sage

Dianoosh Salehi
(Reg. No. 46,352)
For Appellant

MAILED

JAN 15 2008

GROUP 3600

EXAMINER'S ANSWER

This examiner's answer has been prepared in response to appellant's brief on appeal
filed December 21, 2007.

(1) *Real Party in Interest*

A statement identifying by name the real party in interest is contained in the brief.

(James P. Lezie.)

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. (None.)

(3) *Status of Claims*

The statement of the status of claims contained in the brief is correct.

(Claims 1, 4, 5, 7-9, 13, 32, 33, and 37-43 are pending, rejected, and appealed.)

(Claims 2, 3, 6, 10-12, 14-31, and 34-36 have been cancelled.)

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct. (An after-final amendment was submitted by appellant on March 26, 2007 and entered by the examiner on April 2, 2007.)

(5) *Summary of Claimed Subject Matter*

The summary of claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal contained in the brief is correct:

- I. Claims 1, 4, 5, 7-9, 13, 32, 33, and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (US 6,609,050), in view of Moore (US 6,370,454).

(7) *Claims Appendix*

The copy of the appealed claims contained in the Appendix to the brief is substantially correct, but the following errors are noted:

- In claim 1, line 2: "scanning vehicle" should be --scanning a vehicle--;
- In claim 1, line 6: "dataset" should be --data set--; and,
- In claim 1, line 8: "the vehicle" should be --the vehicle service--.

(8) *Evidence Relied Upon*

The following is a listing of the evidence (e.g., patents, publications, official notice, and admitted prior art) relied upon in the rejection of claims under appeal:

US 6,370,454	Moore	4/2002
US 6,609,050	Li	8/2003

(9) *Grounds of Rejection*

I. Claims 1, 4, 5, 7-9, 13, 32, 33, and 37-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Li (US 6,609,050), in view of Moore (US 6,370,454).

Li discloses scanning a vehicle identifier on a vehicle [VIN 300]; transmitting the identifier over a wireless communications link, retrieving the data associated with the VIN in a memory device [C7, ~ L9-L13] and generating a repair order from the data (see “Work Order” in Figure 20); displaying the repair order on a portable device 80 in Figure 20 which shows the “Work Order;” querying a database (querying 93), but Li does not directly disclose using a PDA to obtain current vehicle mileage and other PDA associated steps.

However, Moore discloses obtaining current vehicle mileage with a personal digital assistant [C10, L3-8]; transmitting said data (synchronizing the data throughout the various locations [C10, L11-14] in order to provide a proactive method of maintaining an engine on a vehicle.

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Li as taught by Moore to include Moore’s use of a PDA in Li’s system so that the average person can obtain a complete diagnostic on an automobile in the convenience of their home garage thereby allowing a do-it-yourselfer to save money instead of hiring a professional mechanic to obtain the diagnostics.

(10) Response to Argument

I. Claims 1, 4, 5, 7-9, 13, 32, 33, and 37-43 are unpatentable under 35 U.S.C. 103(a) for being obvious over Li (US 6,609,050), in view of Moore (US 6,370,454).

Regarding the argument that Li does not disclose selecting at least one service item from said service list defined by the current vehicle mileage, the vehicle service history, scheduled maintenance, manufacturer recall, and available service campaigns, the argument is moot for being non-responsive to the actual rejection, since the rejection explicitly stated as much and addressed the stated deficiency, with respect to the “current vehicle mileage.”

Note that, regarding this and other arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

To the extent that appellant is arguing that the references applied in the rejection fail to use the same *names/words* for certain elements as the names used by applicant, the argument is irrelevant, as it is noted that the disclosure in a reference must show the claimed elements arranged in the same manner as in the claims, but *need not be in the identical words* as used in the claims in order to be anticipatory. See *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

To the extent that appellant is arguing that the disclosure in the applied prior art is not in as complete detail as is recited by the instant claims, a reference anticipates a claim if it discloses the claimed invention such that a skilled artisan could take its teachings in

combination with his own knowledge of the particular art and be in possession of the invention.

In re Graves, 36 USPQ2d 1697 (Fed. Cir. 1995); *In re Sasse*, 207 USPQ 107 (CCPA 1980);

In re Samour, 197 USPQ 1 (CCPA 1978).

Additionally, note that, although all claims have been interpreted in light of the specification, limitations from the specification have not been read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Also, during patent examination, the pending claims must be interpreted as broadly as their terms reasonably allow. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

To the extent that appellant is arguing that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case the knowledge generally available to one of ordinary skill in the art would include the necessary motivations and suggestions to combine the references, as set forth in the applied rejection(s). It is the finding of the examiner that making such a modification and/or combination could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results, and the examiner notes that it has been held that the main test for the tenability of any

conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art seeking to solve the same problem, at the time of the invention, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

Moreover, it has been held that, "to constitute patentable invention, an aggregation of old unpatentable elements, parts, or substituted equivalents must cooperate to produce new, unobvious, and unexpected result," and, even "ingenious application of known principles to known problem by use of devices already known and understood to produce predictable result does not amount to invention." *Barrott et al. v. The Drake Casket Company*, 127 USPQ 69 (DC WMich 1960). Therefore, to warrant being rewarded with a patent, appellant's invention must produce something beyond a completely predictable and non-synergistic result, which it does not.


Regarding the argument that the claimed invention would perform better than the method of Li and/or Moore, the fact that appellant has merely recognized another advantage which would flow naturally from following the suggestion of the prior art *cannot* be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

(11) Related Proceeding(s) Appendix

No decision rendered by any court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For all of the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Gerald J. O'Connor
Primary Examiner
Group Art Unit 3627
1/11/08

GJOC

January 11, 2008

Appeal Conference Held:

F. Ryan Zeender 
Supervisory Patent Examiner
Group Art Unit 3627

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Supervisory Patent Examiner
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